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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,683	09/22/2003	Folkert W. Horst	U 014830-3	1545

7590 02/20/2007

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EXAMINER	
BANGACHON, WILLIAM L	
ART UNIT	PAPER NUMBER
2612	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/667,683	HORST ET AL.	
	Examiner	Art Unit	
	William L. Bangachon	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 January 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-21,25,29,31,33,35,37-41 and 43-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-21,25,29,31,33,35,37-41 and 43-45* is/are rejected.

7)☐ Claim(s) *46-49* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *Examiner comment's*.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Remarks, filed 01/25/2007, with respect to the specification and the drawings have been fully considered and are persuasive.

The specification has been amended to remove the objection and therefore withdrawn.

Applicant's argument [see page 23, 3rd paragraph] that the elements recited in claims 18, 33, 35, 38-41 and 43-49 are conventional features for which illustration is not essential for proper understanding is persuasive, and therefore the objection to the drawings is withdrawn.

2. Applicant's arguments with respect to the rejection of claims 14-21, 25, 29, 31, 33, 35, 37-41 and 43-45, have been fully considered but they are not persuasive.

Applicant's argument on page 24, 1st paragraph, with regards to the filing of a terminal disclaimer is persuasive. However, the double patenting rejection is maintained in this Office action due to the non-filing of the terminal disclaimer.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., **"an entire control system embodied as a system located remotely from a locomotive"** [see Remarks, page 25, 2nd paragraph]) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the claims are broader than what applicant argues. And, even if such limitations are claimed, figure 1 of Kisak shows a control system 100, remote from a locomotive that reads on such limitations. The control system 100 is located remotely from a locomotive, located in a tender vehicle separate from the locomotive, described in paragraph 0028 and lines 1-9. Further, a remote locomotive control system 144 and central security control system 140 are also shown in the figure to be clearly located remotely from a locomotive, and as described in paragraph 0029 of Kisak, the remote locomotive control system 144 and central security control system 140 are configured to provide remote control commands to the control system 100.

In response to applicant's argument that **"Kisak does not disclose any form of input for receiving user identification data"** [see Remarks, page 25, 3rd paragraph], applicant is directed to paragraph 0025 of Kisak, wherein Kisak teach that **'the operator authorization input device 136 includes a key or keyboard for entry of a User ID and password or a biometric scanner for receiving fingerprint or retinal features of an operator'**. Clearly, the key or keyboard or biometric scanner is a form of input for receiving a user identification data. With the keyboard, a user types in the User ID. And, in the case of the biometric scanner, the user's fingerprint or retina is scanned, and converted to biometric data of the user. Furthermore, these forms of input for receiving user identification data are conventional features, as admitted by the applicant [see

Remarks, page 22, 1st paragraph]. Based on the above, Kisak clearly reads on the "input for receiving a user identification data", recited in the independent claims.

In response to applicant's argument that **"Kisak does not disclose a processing unit that is operative to transmit a control signal indicative of a command to be executed by the locomotive when the user identification data belongs to an authorized user"** [see Remarks, page 25, 3rd paragraph], applicant is directed to paragraph 0025 of Kisak, wherein Kisak teach that **'the operator authorization input device 136 provides the ability to verify the authorization and authentication of a person attempting to operate the locomotive'**. Clearly, if an operator is not authorized based on an entered User ID, then the unauthorized operator cannot operate the locomotive. That is, the processing unit 102 will not output any commands to operate the locomotive, such as outputting a motor command 130 or shutdown command 132 or startup command 134, shown in figure 1 and described in paragraph 0027. The processing unit 102 may also display the prompt for an authorization input (User ID or user's biometric feature) and indicate the status of the security profile of the locomotive, described in paragraph 0024. Further, if the User ID that was entered is not an authorized User ID, the operation of the locomotive is restricted, described in paragraph 0047-0049. Based on the above, Kisak clearly reads on the "processing unit that is operative to transmit a control signal indicative of a command to be executed by the locomotive when the user identification data belongs to an authorized user", recited in the independent claims.

In response to applicant's argument that the Examiner is using hindsight reasoning [see Remarks, page 25, 4th paragraph], it is noted that independent claim 14, and independent claims 25, 29, 31, 33, 37 and 43, are rejected under 35 U.S.C. 102(e) and therefore there is no reconstruction based upon hindsight reasoning. The argument regarding hindsight reasoning does not apply in this case. And, in response to applicant's argument that Kisak is not sufficient to support a rejection based on anticipation [see Remarks, page 26, 1st paragraph; page 27, 2nd paragraph; page 28, 2nd paragraph; page 30, last paragraph; page 32, 2nd paragraph], as described above Kisak is clearly sufficient to anticipate independent claims 14, 25, 29, 31, 33, 37 and 43.

In response to applicant's argument that Kisak et al does not disclose "transmitting the control signal over a wireless communication link", applicant is directed to paragraphs 0040, 0049, 0056, and Figure 2 of Kisak that describes "transmitting the control signal over a wireless communication link". Kisak states in paragraph 0028 that the remote control system 100 may be in one or more vehicles or locations that are remote from the locomotive and/or that an operator located somewhere other than on board the locomotive provides remote control commands.

In response to applicant's argument that DNA information is not an obvious design choice in the system of Kisak et al [see Remarks, page 33, 2nd paragraph], DNA information is an obvious variation of the biometric feature of Kisak et al that includes retinal information, fingerprint information, hand information, voice information, etc. {see Kisak et al, paragraph 0025}, because DNA information is just another form of a physical feature of a user. Further, applicant admits that such features are conventional

[see Remarks, page 21, 3rd paragraph and page 22, 2nd paragraph]. As such, it would have been just a matter of obvious design choice to one of ordinary skill in the art, at the time of applicant's invention, to include DNA information in the system of Kisak et al because DNA information is just another form of a biometric information, which is an obvious variation of the biometric information in Kisak et al.

In response to applicant's argument that Kisak et al does not disclose an audio prompt or a flashing light [see Remarks, paragraph bridging pages 33 and 4], although Kisak et al does not disclose said prompt is an audio prompt or a flashing light, an audio prompt of flashing light is an obvious variation of the display device 26 and audible alarm 124 of Kisak et al for prompting a user for an authorization input {see Kisak et al, paragraph 0024}. Further, applicant admits that such features are conventional [see Remarks, page 21, 3rd paragraph and page 22, last paragraph]. As such, it would have been just a matter of obvious design choice to one of ordinary skill in the art, at the time of applicant's invention, to include an audio prompt or a flashing light in the system of Kisak et al because an audio prompt or a flashing light are an obvious variation of the display device 26 and audible alarm 124 of Kisak et al for prompting a user for an authorization input.

In response to applicant's argument that "Shapiro does not disclose a processing unit operative to transmit a control signal indicative of a command to be executed by the locomotive" [see Remarks, page 34, last paragraph], the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would

otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Based on the above observations, the rejection of claims 14-21, 25, 29, 31, 33, 35, 37-41 and 43-45, are maintained in this Office action.

3. Applicant's arguments with respect to claims 46-49 have been fully considered and are persuasive, and therefore the rejection of claims 46-49 has been withdrawn.

Election/Restrictions

This application contains claims 1-13, 22-24, 26-28, 30, 32, 34, 36, 42 and 50-56 drawn to an invention nonelected without traverse in Paper No. 05/23/2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. Although the Remarks on page 20, 5th paragraph states the claims have been cancelled, the claims are labeled 'Withdrawn' instead of 'Cancelled'.

Double Patenting

4. Due to the lack of a terminal disclaimer, the double patenting in the previous Office action is maintained in this Office action.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 14, 25, 29, 31, 33, 35, 37 and 43 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-4, 11, 13-14, 20 and 22-23 of copending Application No. 10/667,641. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14, 25, 29, 31, 33, 35, 37 and 43 are broader than the combination of claims 1 and 3-4 or 11 and 13-14 or 20 and 22-23, in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 14-21, 25, 29, 31, 33, 37, 39, 41 and 43-45 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Publication 2004/02454410 {Kisak et al}.

In claim 14, Kisak et al teach of a remote control device (100) for controlling a locomotive (202), said remote control device comprising:

(a) a first input (e.g. reverser 118, throttle 120, AESS 122, communications interface 138, engine control hardware 106) for receiving a command signal from a user, the command signal being indicative of a command to be executed by the locomotive (202) {see paragraph [0027]};

(b) a second input (e.g. operator authorization input device 136) distinct from said first input, said second input being adapted for receiving user identification data {see paragraph [0025]};

(c) a processing unit (102) operative to transmit a control signal indicative of a command to be executed by the locomotive when the user identification data belongs to an authorized user {see paragraphs [0027], [0035]+}. Also see paragraphs 0047-0049.

In claim 15, a remote control device as defined in claim 14, wherein Kisak et al further teaches of a user authentication unit (102) that is in communication with said second input (136), said user authentication unit (102) being adapted for:

(a) receiving the user identification data; and

(b) processing the user identification data to generate verification data indicative of whether the user identification data belongs to an authorized user {see paragraphs [0027], [0035]+}.

In claim 16, Kisak et al teach that said remote control device is adapted for storing data relating to command signals entered at said first input {see paragraph [0027]}.

In claims 17-18, Kisak et al teach that said user identification data includes a biometrics parameter (e.g. fingerprint, retina, voice) {see paragraph [0025], lines 3-7}.

In claims 19-20, Kisak et al teach that the user identification data includes user-supplied information (e.g. User ID entered through a keyboard) {see paragraph [0025], line 5+}.

In claim 21, Kisak et al teach that said user-supplied information is stored on a computer readable storage medium (i.e. card), said second input (i.e. card reader 136) being adapted for reading said computer readable storage medium for extracting said user-supplied information {see paragraph [0025], line 5+}.

Claim 25 recites a method for practicing the device of claim 14 and therefore rejected for the same reasons, further comprising "transmitting the control signal over a wireless communication link" wherein Kisak states in paragraph 0028 that the remote control system 100 may be in one or more vehicles or locations that are remote from the locomotive and/or that an operator located somewhere other than on board the locomotive provides remote control commands from a remote locomotive control system

144 or central security control system 140 via a wireless communication link, described in paragraphs 0029, 0040, 0049 and 0056. Also see Figure 2.

Claims 29 and 33 recites the combination of claims 15 and 18 and therefore rejected for the same reasons.

Claim 31 recites the limitations of claim 15 and therefore rejected for the same reasons.

Claim 37 recites the limitations of claim 14 wherein Kisak et al further teach:

(c) said remote control device being adapted to issue a prompt for indicating to a user to provide user identification data {see paragraph [0024, lines 12-14+]};

In claims 39 and 41, said prompt is a visual prompt through display device 126 such as a text message displayed to the user {see paragraph [0024, lines 12-14+]}.

Claim 43 recites the limitations of claim 15 wherein Kisak et al further teach that:

in response to a transmission termination event (i.e. operator is not an authorized user), said processing unit being adapted to cease the transmission of control signals indicative of commands to be executed by the locomotive {see paragraph [0032+], [0035-0036+], [0044]}.

In claim 44, Kisak et al teach that said transmission termination event includes a termination signal from a central security control system 140 {see paragraph [0031]}.

In claim 45, Kisak et al teach that said remote control device includes an input (136) for enabling a user to enter the termination signal. In this case, when the operator is immobilized and unable to control operation of the locomotive, remote control

commands from a central security control system (140) is used to activate a dump valve and automatically engage air brakes {see paragraph [0031]}.

12. Claims 35, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2004/02454410 {Kisak et al}.

Claim 35 recites the combination of claims 15 and 18. Kisak et al does not disclose "DNA information". However, DNA information is an obvious variation of the biometric feature of Kisak et al including retinal information, fingerprint information, hand information, voice information, etc. described in paragraph 0025. Further, these are conventional features {see Remarks, page 21, 3rd paragraph and page 22, 2nd paragraph}. As such, it would have been just a matter of obvious design choice to one of ordinary skill in the art, at the time of applicant's invention, to include DNA information in the system of Kisak et al because DNA information is just another form of a biometric information, which is an obvious variation of the biometric information in Kisak et al.

In claims 38 or 40, although Kisak et al does not disclose said prompt is an audio prompt or a flashing light, an audio prompt of flashing light is an obvious variation of the display device 26 and audible alarm 124 of Kisak et al described in paragraph 0024. Further, these are conventional features {see Remarks, page 21, 3rd paragraph and page 22, last paragraph}. As such, an audio prompt or a flashing light is just a matter of obvious design choice and would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include in the system of Kisak et al because an

audio prompt or a flashing light are an obvious variation of the display device 26 and audible alarm 124 of Kisak et al.

Allowable Subject Matter

13. Claims 46-49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Office Contact Information

15. Please note that the Examiner's supervisor has been changed.

16. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to William Bangachon whose telephone number is **(571)-272-3065**. The Examiner can normally be reached from Monday through Friday, 7:30 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Brian Zimmerman can be reached on **(571)-272-3059**. The fax phone numbers for the organization where this application or proceeding is assigned is **571-273-8300** for regular and After Final formal communications. The Examiner's fax number is **(571)-273-3065** for informal communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

William L Bangachon
Examiner
Art Unit 2635

February 13, 2007

BRIAN ZIMMERMAN
PRIMARY EXAMINER